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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|--------------------------------|
| 10/627,217 | 07/25/2003 | James T. Caudle | 24059-3 | 2428 |
| 7590 | 03/17/2004 | | | EXAMINER GONZALEZ, MADELINE |
| Woodard, Emhardt, Moriarty, McNett & Henry LLP Bank One Center/Tower 111 Monument Circle, Suite 3700 Indianapolis, IN 46204-5137 | | | ART UNIT 2859 | PAPER NUMBER |
| DATE MAILED: 03/17/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/627,217 | CAUDLE, JAMES T. | |
| | Examiner | Art Unit | |
| | Madeline Gonzalez | 2859 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 July 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

Drawings

1. Figures 1-4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7: The claim recites the limitation “a locking mechanism for holding a flat, not “T-shaped” measuring blade”. This limitation is confusing since applicant already claimed a flat, not “T-shaped” measuring blade in claim 6. Is applicant claiming a second measuring blade?

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3-5, 7 and 8 are rejected under 35 U.S.C. 102(a) as being anticipated by John P. Smith.

John P. Smith discloses a tool, as shown in page 1, including:

- a flange-contacting portion for contacting the flange of an I-beam along the line where the flange intersects the web of the beam, as shown in page 2;
- a flat measuring blade for measuring distances from said flange-contacting portion along the web of the beam, wherein said flat measuring blade is not "T-shaped";
- a blade-gripping portion for holding said flat, not "T-shaped" measuring blade;
- a bridging portion for connecting said measuring blade portion to said flange-contacting portion by bridging the beam flange, wherein said bridging portion connects said measuring blade to said flange-contacting portion in a way in which the measuring blade is perpendicular to a line parallel to the flange;
- wherein said flange-contacting portion extends in both directions along the line where the flange intersects the web of the beam, relative to the position of the measuring blade;
- a locking mechanism for releasably holding said measuring blade; and

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- a handle portion for providing a better grip on the tool.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over John P. Smith in view of McDanel (U.S. 1,826,807).

John P. Smith discloses all the subject matter claimed above in paragraph 5 with the exception of a rib for contacting the flange.

With respect to the rib for contacting the flange: McDanel discloses a gauge, as shown in Fig. 1, having a leg including a projection 6 (rib) contacting the outside face of the beam flange opposite the beam web, said projection 6 (rib) providing accurate positioning of the gauge. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a rib as taught by McDanel to the tool disclosed by John P. Smith in order to assure an accurate positioning of the tool, as already suggested by McDanel.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Guillen and Sloan et al. ('390) disclose an I-beam measuring device having a flange-contacting portion and a bridging portion connecting a measuring portion to the flange-contacting portion. Shlager discloses a layout tool for locating holes on structural steel. Veeze discloses a device having a block 5 (flange-contacting portion), a bar 10 (measuring blade) and a plate 8 (bridging portion). Wheeler discloses a steel worker's layout tool. Roe, O'Sullivan and Hull disclose related measuring devices having a hooking portion. Tierney discloses a marking device. Stark discloses a gauge. Fisher discloses a layout tool having a flange-contacting portion, a measuring blade, and a bridging portion connecting the flange-contacting portion with the blade. Doyle discloses a square. Coe discloses a flange gauge.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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